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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/386,335	Applicant(s) YODA ET AL.	
	Examiner CHAN S. PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


TWYLER LAMB
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/7/05, and has been entered and made of record. Currently, **claims 1-19** are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 15 and 19, as currently amended, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 19 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that the claims fail to correspond in scope with that which applicant regard as the invention can be found in the reply filed 6/7/05. In that paper, applicant has stated the original Specification (page 47, lines 1-24) has support the limitations cited in the claims, and this statement indicates that the invention is different from what is defined in the claims because the cited section does not teach/disclose anything about reading out

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information periodically. Rather, the specification states "[t]he transmission means periodically reads out for a corresponding storage means and if there is stored a document image, registers it in a predetermined system." The specification appears to indicate that the actual document is read out for the determination.

Clarification/explanation is respectfully requested.

Claim 1 recites the limitation "transmitting means for periodically reading from the storage means to determine if the information relating to the document image is stored". It is uncertain as to what exactly is being read out for the determination. It is noted that the storage means stores both the document image and the information relating to the document image. Is it the document image that is being read or the information? Or is it both or something else?

With respect to claim 19, arguments analogous to those presented for claim 1, are applicable.

Claims 1 and 19 recite the limitation "the read out information". There is insufficient antecedent basis for this limitation in the claim. Again, it is uncertain as to whether this limitation is referring to the document image, the information relating to the document image, or something else.

With respect to claim 2, it recites "transmitting the document image to one of the at least one system based on the information relating to the document image read out". As set forth above, it is uncertain as to when this information is read out. Is this also read out periodically? If so, where is shown in the Specification?

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With respect to claim 15, it is unclear as to where this "sub-storage means" is located. Further, Examiner initially noted that the document image is transmitted from the one of the digital copier not from the transmitting means. Does the transmitting means transmit the document image back to the storage means to be stored in the sub-storage means? Does it transmit back after the periodic read out?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 15, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsukamoto et al. U.S. Patent No. 6,559,964 (hereinafter Tsukamoto).

4. With respect to claim 1, Tsukamoto discloses a document input system comprising:

at least one digital copier (120) for inputting a document image (col. 3, lines 32-41) and information relating to the document image, the information including information about a transmission destination (col. 4, line 67 – col. 5, line 4 & col. 29, lines 14-18);

at least one system serving as a transmission destination (121 or 122 in fig. 2) of the document image inputted by the at least one digital copier;

storage means (RAM 103) for storing the document image inputted by the at least one digital copier and information relating to the document image (col. 5, lines 29-49); and

transmitting means (server 118) for periodically reading from the storage means to determine if the information relating to the document image is stored in the storage means (col. 7, lines 46-52) and, if so, transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image (col. 8, lines 11-15).

5. With respect to claim 10, Tsukamoto discloses the document input system according to claim 1, wherein the transmission destination is a document filing system, the transmitting means determines a title of a document image based on the information relating to the document image stored in the storage means and the determined title and the document image corresponding to the determined title are transmitted to the document filing system (col. 8, lines 11-15).

6. With respect to claim 15, Tsukamoto discloses the document input system according to claim 1, further comprising sub-storage means for storing the document image transmitted from the transmitting means (figs. 3 & 4),

wherein the transmitting means, after the document image stored in the storage means is stored in the sub-storage means, transmits the document image to the transmission destination (col. 8, lines 1-18).

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7. With respect to claim 17, Tsukamoto discloses the document input system according to claim 15, wherein a storage area of the sub-storage means is divided for the at least one system (figs. 3 & 4).

8. With respect to claim 19, arguments analogous to those presented for claim 1, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto.

9. With respect to claim 4, Tsukamoto discloses the document input system according to claim 1, wherein the digital copier comprises job history storage means for storing history of various jobs including an input of the document image (col. 12, lines 52-58). Although Tsukamoto does not disclose expressly that the history indicating an occurrence of error, it would have been obvious to one of ordinary skill in the art at the time invention was made to indicate the occurrence of the error to the user. The suggestion/motivation for doing so would have been to give a detail transfer result to the user. Therefore, it would have been obvious to obtain the invention as specified in claim 4.

Claims 2, 3, 5, 7, 9, 11, 12-14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto as applied to claim 1 above, and further in view of Unno U.S. Patent No. 6,437,875.

10. With respect to claim 2, Tsukamoto discloses the document input system according to claim 1, wherein storage means includes sub-storage means, provided so as to correspond to the at least one system respectively, for storing the document image and the information relating to the document image (figs. 3 & 4).

Tsukamoto, however, does not disclose expressly the transmitting means including sub-transmitting means, provided so as to correspond to the at least one system respectively, for transmitting the document image to one of the at least one system based on the information relating to the document image read out.

Unno, the same field of endeavor of the document image processing apparatus, discloses a document input system (fig. 13 and col. 12, lines 33-45) comprising:

at least one digital copier (sending device) for inputting a document image and information relating to the document image; the information including information about a transmission destination (figs. 25-27 & 37);

at least one system serving as a transmission destination (clients in fig. 13) of the document image inputted by the at least one digital copier;

storage means (receiving device) for storing the document image inputted by the at least one digital copier and information relating to the document image; and

transmitting means for transmitting the document image corresponding to the information to one of the at least one system based on the read out information relating

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to the document image (fig. 12; col. 5, lines 30-35; col. 11, lines 1-64; & col. 14, lines 10-39). Note that the examiner also interprets the servers in the network (fig. 1) as the transmitting means (col. 5, lines 30-35).

Furthermore, Unno discloses the apparatus, wherein
the storage means includes sub-storage means (Notes DB, DB, Mail server, and DOX DB in fig. 13), provided so as to correspond to the at least one system respectively, for storing the document image and the information relating to the document image, and

the transmitting means includes sub-transmitting means (4450, 4500, 4550, and 4600 in fig. 13), provided so as to correspond to the at least one system respectively, for transmitting the document image to one of the at least one system based on the information relating to the document image read out.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the sub-transmitting means of Unno into the document input system of Tsukamoto.

The suggestion/motivation for doing so would have been to use appropriate transmitting means based on the destination.

Therefore, it would have been obvious to obtain the invention as specified in claim 2.

11. With respect to claim 3, Tsukamoto discloses the document input system, wherein the digital copier comprises:

image input/output processing means for inputting the document image (col. 3, lines 31-41);

management means for inputting information relating to the document image inputted by the image input/output processing means (col. 4, line 67 – col. 5, line 4); and

image input control means for determining a system which is a transmission destination of the document image inputted by the image input/output processing means based on the information relating to the document image inputted by the management means and storing the document image in the sub-storage means corresponding to the determined system (figs. 3 & 4).

12. With respect to claim 5, Tsukamoto discloses the document input system, wherein the image input control means generates title for the document image based on information relating to a document image inputted by the management means and stores the generated title in the storage means with the document image (col. 5, lines 29-40).

13. With respect to claim 7, Unno discloses the document input system, further comprising second storage means in which data storing time is longer than that of the storage means, and the transmitting means transfers the document image stored in the storage means and the information relating to the document image to the second storage means (col. 6, lines 5-6 & col. 18, lines 4-10 discloses the method of storing the image data in the HD). It would have been obvious to use the HD of Unno to store the image data longer.

14. With respect to claim 9, Unno discloses the document input system wherein until resetting to the information relating to the document image inputted by the management means is specified or a predetermined time passes after the document image is inputted by the image input/output processing means, the image input control means treats the document image inputted by the image input/output processing means as a series of information (col. 10, lines 33-49 & col. 16, lines 8-19).

15. With respect to claim 11, Unno discloses the document input system wherein, the transmission destination is E-mail server and the transmitting means transmits a document image stored in the storage means to the E-mail server as an attached file of an E-mail (col. 14, lines 30-39). It would have been obvious to incorporate the email transmission method of Unno into the document input system of Tsukamoto. The suggestion/motivation for doing so would have been to send the facsimile data in the Internet.

16. With respect to claim 12, Unno discloses the document input system further comprising recognition means for recognizing a character string included in the document image stored in the storage means, wherein the transmission destination is an E-mail server and the transmitting means transmits the character string recognized by the recognition means to the E-mail server as data of a context of an E-mail (fig. 37 & col. 5, lines 30-35). Also, it is well known in the art that a character string "@" is recognized as an email address by the conventional network system. It would have been obvious to incorporate the email transmission method of Unno into the document

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input system of Tsukamoto. The suggestion/motivation for doing so would have been to send the facsimile data in the Internet.

17. With respect to claim 13, Unno discloses the document input system wherein, the transmission destination is a groupware server and the transmitting means transmits the document image stored in the storage means to the groupware server (col. 14, lines 21-39 and fig. 1). It would have been obvious to combine Tsukamoto with Unno to transmit image data to a groupware server for further processing and transmission.

18. With respect to claim 14, Unno discloses the document input system wherein, the transmission destination is a client computer having a program for document edition and the document image transmitted from the transmitting means is used by the program (col. 14, lines 21-39). It is well known to the one of ordinary skill in the art that the received Email image can well be saved and edited by the user at the PC using a program for document edition. Thus, it would have been obvious to include the document editing program at the receiving PC to modify/edit the received document.

19. With respect to claim 16, Unno discloses the document input system further comprising sub-storage means for storing the document image transmitted from the transmitting means, wherein the transmitting means, if the document image information stored in the storage means can be transmitted to the transmission destination, transmits the document image information to the transmission destination and if not, stores the document image information in the sub-storage means (col. 22, lines 5-12). It is well know to one of ordinary skill in the art to save the untransmitted/unprocessed

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until it is completed. The motivation for doing so would have been to keep the data even if an error is occurred.

20. With respect to claim 18, Unno discloses the document input system wherein a storage area of the sub-storage means is divided for the at least one system (fig. 13).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tsukamoto and Unno as applied to claim 5 above, and further in view of Mori et al. U.S. Patent No. 6,292,267 (hereinafter Mori).

21. With respect to claim 6, the combination of Tsukamoto and Unno discloses the document input system according to claim 5, but it does not disclose expressly that the image input control means assigns priorities to the information relating to the document image and generates title for the document image based on the priorities.

Mori, the same field of endeavor of the document processing, discloses a system for assigning priorities to the information relating to the document image and generates title for the document image based on the priorities (col. 44, lines 61-67).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have to modify the system to assign priorities to the document image.

The suggestion/motivation for doing so would have been to process the urgent document first.

Therefore, it would have been obvious to combine the three references to obtain the invention as specified in claim 6.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tsukamoto as applied to claim 1 above, and further in view of Okamura et al. U.S. Patent No. 6,266,162 (hereinafter Okamura).

22. With respect to claim 8, Tsukamoto discloses the document input system according to claim 1, but it does not disclose expressly whether an occurrence of an error after an input of the document is notified at the digital copier.

Okamura, the same field of endeavor of the network digital copier/facsimile, disclose a method of notifying of the error after an input of the document (col. 19, lines 47-51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have to modify the system to store the transmission error report at the digital copier/facsimile.

The suggestion/motivation for doing so would have been to notify the user of transmission results when there is an error.

Therefore, it would have been obvious to combine Tsukamoto with Okamura to obtain the invention as specified in claim 8.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CHAN S. PARK** whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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csp
August 18, 2005

Chan S. Park
Examiner
Art Unit 2622



TWYLER LAMB
PRIMARY EXAMINER